REMARKS/ARGUMENTS

Claims 1-40 remain in the application for further prosecution.

Claim Rejections - 35 U.S.C. § 103

Claims 1-28 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,544,120 ("Ainsworth '120") in view of U.S. Publication No. 2002/0047238 (Ainsworth '038") and U.S. Publication No. 2005/0130731("Englman").

Claims 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Ainsworth '120 in view of U.S. Publication No. 2003/0054872 ("Locke").

With regard to the rejections based on Ainsworth '120, Ainsworth '038 and Englman, Englman was filed on December 10, 2003 as serial number 10/731,941 while the present application was filed on January 16, 2004. Applicant is submitting as Exhibit A the assignment and Notice of Recordation for the present application to WMS Gaming, Inc. dated January 16, 2004 and recorded on January 16, 2004 under reel 014905, frame no. 0343. Exhibit B is a record of the assignments for the inventors of U.S. Publication No. 2005/0130731, Allon G. Englman and Joel R. Jaffe to the common owner, WMS Gaming dated December 9, 2003 and recorded on December 10, 2003 under reel 014799, frame no. 0015.

Based on these documents, Applicant respectfully submits that Englman is therefore not proper prior art under 35 U.S.C. 103(c)(1). As Section 706.02(l)(2) of MPEP states, "**In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned**, or subject to an obligation of assignment to a same person, **at the time the claimed invention was made**." (emphasis added). Since WMS Gaming, Inc. commonly owned

both the present application and the alleged Englman prior art at the time the invention was made, Englman is not prior art.

Since Englman is not proper prior art under 35 U.S.C. 103, Applicant respectfully submits that the pending claims are allowable over the Ainsworth references for the same reasons stated in the previous amendment and response. These include the fact that the combination of the Ainsworth references does not disclose or suggest "adding the second plurality of symbols between at least some of the first plurality of symbols in the first array to form the second array" as required in the pending claims.

With regard to claims 29-36, the Final Office Action has cited Ainsworth '120 in combination with Locke. Locke was filed on September 1, 2001 and published on March 20, 2003, making it prior art under 35 U.S.C. 102(e)(1). Exhibit C is a record of the assignments for the inventors of Locke, David Locke and Marc Raneses to the common owner, WMS Gaming dated August 29, 2001 and recorded on September 10, 2001 under reel 012162, frame no. 0259. 35 U.S.C. 103(c)(1) states that "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Since WMS Gaming, Inc. commonly owned both the present application and the alleged Locke prior art at the time the invention was made, Applicant respectfully submits that Locke is therefore not proper prior art under 35 U.S.C. 103(c)(1).

The Final Office Action concedes that Ainsworth does not teach that modifier symbols are used to form a second array or used to modify the array to form a modified array where the

modifier symbols represent a mathematical function. (p. 6). Since Locke is not a proper reference under 35 U.S.C. 103(c)(1), these claims are allowable because Ainsworth '120 does not anticipate the above elements and for the reasons stated in the previous amendment including requiring a random selection of a plurality of modifier symbols without player input.

Conclusion

It is Applicant's belief that all of the claims are now in condition for allowance and actions towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

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/Wayne L. Tang – Reg. 36,028/
Wayne L. Tang
Reg. No. 36,028
NIXON PEABODY, LLP.
161 N. Clark Street, 48th Floor
Chicago, Illinois 60601-3213
(312) 425-3900
Attorney for Applicants